

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed August 16, 2006. Reconsideration and allowance of the application and presently pending claims 1, 3-8, and 10-28 are respectfully requested.

### **1. Response to Rejection of Claims Under 35 U.S.C. § 102(a)**

In the Office Action, claims 1-8 and 10-28 stand rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable by *Tonkin* (WO 01/031465). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

#### **a. Claim 1**

As provided in independent claim 1, Applicants claim:

A method comprising:

receiving, via at least one network service, imaging data that is to be included in a booklet;

***prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data;***

receiving, via said at least one network service, user input for incorporating the imaging data into the booklet;

building, via said at least one network service, a booklet incorporating imaging data in accordance with said user input; and

***printing the booklet on a network-accessible printer designated by user input.***

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data" and "printing the booklet on a network-accessible printer designated by user input," as recited and emphasized above in claim 1.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest "prior to receiving said imaging data, causing, via at least one network service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet, and wherein said receiving imaging data comprises receiving user selection of said imaging data," as recited in claim 1. For example, the Office Action construes a network service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 causes a user interface to be presented which allows a user to select imaging data for use in making a booklet (where the imaging data was received by the document production hub 60). Rather, *Tonkin* seemingly describes that document composition and selection of content takes place before a file is uploaded and then afterwards, assembly options are provided.

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. See page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "printing the booklet on a network-accessible printer designated by user input," as recited in claim 1.

Accordingly, *Tonkin* does not anticipate claim 1, and the rejection of claim 1 should be withdrawn.

b. Claims 2-8 and 28

Because independent claim 1 is allowable over the cited art of record, dependent claims 3-8 and 28 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features of independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). For at least this reason, the rejections of claims 3-8 and 28 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 3-8 and 28, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

Claim 2 is canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to the claim is rendered moot. Applicants take this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of the canceled claim in a continuing application, if Applicants so choose, and do not intend to dedicate any of the canceled subject matter to the public.

c. Claim 10

As provided in independent claim 10, Applicants claim:

One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

***send content to a client device for execution by a client browser, said content enabling the client device to:***

***display a user interface that is configured to enable a user to select imaging data for use in building a booklet;***

provide, over a network, a user selection of imaging data for use in building the booklet;

provide, over the network, user input for incorporating the imaging data into the booklet; and

***provide, over the network, user input for designating a network location for printing the booklet.***

(Emphasis added).

Applicants respectfully submit that independent claim 10 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature to "send content to a client device for execution by a client browser, said content enabling the client device to: display a user interface that is configured to enable a user to select imaging data for use in building a booklet" or "provide, over the network, user input for designating a network location for printing the booklet," as recited and emphasized above in claim 10.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest to "send content to a client device for execution by a client browser, said content enabling the client device to: display a user interface that is configured to enable a user to select imaging data for use in building a booklet," as recited in claim 10. For example, *Tonkin* does not disclose that a document production hub 60 or other device enables a client device to display a user interface that is configured to enable a user to select imaging data for use in building a booklet.

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. See page 17, lines 8-22. As such, *Tonkin* fails

to teach or suggest to "provide, over the network, user input for designating a network location for printing the booklet," as recited in claim 10.

Accordingly, *Tonkin* does not anticipate claim 10, and the rejection of claim 10 should be withdrawn.

d. Claims 11-13

Because independent claim 10 is allowable over the cited art of record, dependent claims 11-13 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features of independent claim 10. For at least this reason, the rejections of claims 11-13 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 11-13, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

e. Claim 14

As provided in independent claim 14, Applicants claim:

A method comprising:

***causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet;***

receiving, via said at least one Web service, a user selection of imaging data;

receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet;

building, via said at least one Web service, a booklet incorporating imaging data received from said user input; and

***printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user.***

(Emphasis added).

Applicants respectfully submit that independent claim 14 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet" and "printing, via said at least one Web service, the booklet on a

Web-accessible printer designated by the user," as recited and emphasized above in claim 14.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest "causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet," as recited in claim 14. For example, the Office Action construes a Web service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 causes a user interface to be presented which allows a user to select imaging data for use in making a booklet (where the imaging data was received by the document production hub 60).

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. See page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user," as recited in claim 14.

Accordingly, *Tonkin* does not anticipate claim 14, and the rejection of claim 14 should be withdrawn.

f. Claims 15-17

Because independent claim 14 is allowable over the cited art of record, dependent claims 15-17 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features and steps of independent claim 14. For at least this reason, the rejections of claims 15-17 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 15-17, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

g. Claim 18

As provided in independent claim 18, Applicants claim:

A method comprising:

receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

***receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet;***

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

building, via said at least one Web service, a booklet incorporating imaging data received from said user input.

(Emphasis added).

Applicants respectfully submit that independent claim 18 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet," as recited and emphasized above in claim 18.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g.,

transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created.” Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest “receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet,” as recited in claim 18. For example, the Office Action construes a Web service to be a document production hub 60 in *Tonkin* but *Tonkin* does not disclose that a document production hub 60 receives user input for incorporating imaging data into a booklet.

Accordingly, *Tonkin* does not anticipate claim 18, and the rejection of claim 18 should be withdrawn.

h. Claims 19-21

Because independent claim 18 is allowable over the cited art of record, dependent claims 19-21 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features and steps of independent claim 18. For at least this reason, the rejections of claims 19-21 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 19-21, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

i. Claim 22

As provided in independent claim 22, Applicants claim:

One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

***receive, via said at least one Web service, user input for incorporating the imaging data into the booklet;***

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

build, via said at least one Web service, a booklet incorporating imaging data received from said user input.

(Emphasis added).

Applicants respectfully submit that independent claim 22 is allowable for at least the reason that *Gottfreid* does not disclose, teach, or suggest at least to "receive, via said at least one Web service, user input for incorporating the imaging data into the booklet," as recited and emphasized above in claim 22.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest to "receive, via said at least one Web service, user input for incorporating the imaging data into the booklet," as recited in claim 22. For example, the Office Action construes a Web service to be a document production hub 60 in *Tonkin* but *Tonkin*

does not disclose that a document production hub 60 receives user input for incorporating imaging data into a booklet.

Accordingly, *Tonkin* does not anticipate claim 22, and the rejection of claim 22 should be withdrawn.

j. Claim 23

As provided in independent claim 23, Applicants claim:

A booklet-making method comprising:

***browsing to a Web-accessible booklet-making service;***  
***specifying to said Web-accessible booklet-making service***  
***imaging data that is to be used to make a booklet and how that***  
***imaging data is to be used;***

constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data; and

***forwarding, from said Web-accessible booklet-making***  
***service, the booklet to a network printer designated by a user.***

(Emphasis added).

Applicants respectfully submit that independent claim 23 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "browsing to a Web-accessible booklet-making service," "specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used," or "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user," as recited and emphasized above in claim 23.

Rather, *Tonkin* discloses at most a system whereby "upon invocation of the printer driver: a preview of the document is displayed; the document is uploaded to the document production hub upon request from the user; and then a communication link is opened with the document production hub." Page 12, lines 25-30. Therefore, the document is previewed before the document is ever uploaded to the document production hub in *Tonkin*. After the document is uploaded, the user can specify document assembly instructions and then preview the document as so assembled. Page 15, lines 24-26. "The specified assembly instructions might include for example: type and color of the paper or other media (e.g., transparencies) to be used for printing the uploaded document; type, size and color of the binding or clips to be used; type and color of the front cover and back cover; type and position of any tab pages, together with a specification of any content to be

printed on each tab page; and the number of copies of the assembled document to be created." Pages 15-16, lines 30-5. As such, *Tonkin* fails to teach or suggest "browsing to a Web-accessible booklet-making service" and "specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used," since in *Tonkin*, a document is uploaded to a document production hub in response to selection of a print driver and not browsing to a Web-accessible booklet-making service.

Further, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. See page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user," as recited in claim 23.

Accordingly, *Tonkin* does not anticipate claim 23, and the rejection of claim 23 should be withdrawn.

k. Claim 24

Because independent claim 23 is allowable over the cited art of record, dependent claim 24 is allowable as a matter of law, for at least the reason that the dependent claim contains all the features and steps of independent claim 23. For at least this reason, the rejection of claim 24 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claim 24, this claim recites further features and/or combinations of features (as are apparent by examination of the claim itself) that are patentably distinct from the cited art of record. Hence, there are other reasons why this claim is allowable.

I. Claim 25

As provided in independent claim 25, Applicants claim:

A web service comprising:  
means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet;

means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet;

***means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet; and***

means, operably associated with the Web, for building the booklet.

(Emphasis added).

Applicants respectfully submit that independent claim 25 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least "means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet," as recited and emphasized above in claim 25.

Rather, in *Tonkin*, a user can select a virtual printer. In the example of FIG. 5, a user has selected the virtual printer "Print to Kinko's" from the list of printers. Selection of this virtual printer does not designate a network-accessible printer where a booklet is to be presented, however. Rather, selection of the "Print to Kinko's" virtual printer only specifies a production facility and not a particular network printer within the production facility. See page 17, lines 8-22. As such, *Tonkin* fails to teach or suggest "means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet," as recited in claim 25.

Accordingly, *Tonkin* does not anticipate claim 25, and the rejection of claim 25 should be withdrawn.

m. Claims 26-27

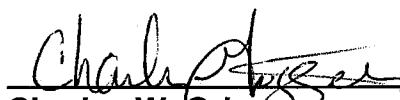
Because independent claim 25 is allowable over the cited art of record, dependent claims 26-27 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features of independent claim 25. For at least this reason, the rejections of claims 26-27 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 26-27, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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